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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,372	06/29/2000	Toshiaki Saito	862.C1936	7361

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EXAMINER

POON, KING Y

ART UNIT PAPER NUMBER

2624

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/605,372

Applicant(s)

SAITO ET AL.

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005 and 22 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-23 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,16-18 and 21-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4,11-14 and 19 is/are allowed.
- 6) ☒ Claim(s) 5,6,10,15 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 7, 8, 16-18, 21-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/16/2005.
2. The new title filed 7/22/2004 has been accepted.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations of "An image communication apparatus for communicating a color image according to at least one ITU-T recommendation from a transmitting side comprising: printing means for printing a color image on the basis of an image signal,

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determination means for determining a color printing capability of said printing means based on a type of color ink set and a type of printing medium in said printing means and transmission means for transmitting information about the color printing capability determined by said determination means to the transmitting side using a control signal based on the recommendation" is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

By applicant's election, claim 10's image communication apparatus is being used as image transmitting apparatus based on the response filed on 3/16/2005. Claim 10 is claiming an image communication apparatus used to transmit a color image from a transmitting side (which is the image communication apparatus). The apparatus comprising a printing means, a determining means, and a transmission means. The transmission means is used to transmit color printing capability to the image communication apparatus using a signal based on ITU-T recommendation. The combination of claimed limitations does not seem to be disclosed in the specification- especially, the limitation of "transmission means used to transmit color printing capability to the image communication apparatus that comprises the transmission means, using a signal based on ITU-T recommendation."

The examiner has search for the claimed limitations based on the interpretations described above, and cannot locate any prior art to apply a rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 15, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murayama (US 5,937,106) in view of Sakamoto et al (US 5,719,686).

Regarding claims 5, 15: Murayama teaches an image communication apparatus (fax machine, column 3, lines 58-61) for transmitting a image according to at least one ITU-T recommendation (column 8, lines 22-30) to a receiving apparatus (fax inherently requires a receiving apparatus) comprising: original read means (2, fig. 1) for generating image data by reading an original; identification means (column 3, lines 67-column 4, lines 1-2) for identifying a paper size of the original read by said original read means; compression means (coding device, column 4, lines 15-17) for compressing the image data; and control means (column 4, lines 24-27) for, in a case where the paper size of the original, identified by said identification means is smaller than a paper size defined by the recommendation (column 8, lines 60-67), causing said original read means to read the original in the paper size of the original (column 9, lines 13-14) and causing said compressing means to compress the read image data (column 4, lines 15-20), and performing control to designate the paper size of the original (column 9, lines 15-20) in a case where the image data compressed by said compression means is transmitted (abstract).

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Murayama does not teach color facsimile.

Sakamoto, in the same area of facsimile according to ITU-T recommendation, teaches color facsimile is being standardized under ITU-T recommendation.

Since Murayama is using ITU-T recommendation, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Murayama's invention by applying his concept of operating a facsimile apparatus to a color facsimile apparatus.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Murayama's invention by the teaching of Sakamoto because of the following reasons: (a) it would have allowed his invention's user of enjoying the pleasure of color facsimile and (b) it would have allowed color facsimile possible by complying with the ITU-T recommendation standard.

Regarding claim 20: Murayama teaches a computer readable storage medium (column 4, line 26) to store a program for the fax machine discussed in claims 5, 11.

7. Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murayama (US 5,937,106) in view of Sakamoto et al (US 5,719,686) as applied in claim 5 above and further in view of Takeda (US 5,485,282).

8. Regarding claim 6: Murayama teaches designates paper size of the original (column 7, lines 5-10). Murayama also mention that if receiver is not capable of receiving the document in a size, then the document size is changed accordingly (column 1, lines 55-60).

Murayama does not, in the detail description, disclose: determination means for determining whether the receiving apparatus has a receiving capability of receiving image data of the paper size smaller than the paper size defined by the recommendation, and said control means designates the paper size of the original with respect to the receiving apparatus in a case where said determination means determines that the receiving apparatus has the receiving capability.

Takeda, in the area of facsimile transmission, discloses that a fax apparatus contains determining means RDCLP, performed by communication controller 2, for determining whether a receiving apparatus has a receiving capability of receiving image data of a size smaller than the page size defined by the recommendation; in Takeda's system the document size and resolution capable of being received on the receiving side is communicated to the sending apparatus by RDCLP via communication controller 2 (col. 4 lines 28-30).

Takeda further discloses that the control means designates the size of the image with respect to the receiving apparatus when the receiving apparatus has the capability; in Takeda's system, through the CDCL and RDCLP the sending apparatus sets the image size to be printed after communication regarding available paper size from the receiving side (col. 4 lines 34-36 and 46-50).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Murayama to include: determination means for determining whether the receiving apparatus has a receiving capability of receiving image data of the paper size smaller than the paper size defined by the

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recommendation, and said control means designates the paper size of the original with respect to the receiving apparatus in a case where said determination means determines that the receiving apparatus has the receiving capability.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Murayama by the teaching of Takeda because it would have prevented sending fax information to a party that the information cannot be received and waste time, network bandwidth, expensive resource such as electric power-especially such problem is already recognized by Murayama.

***Allowable Subject Matter***

9. Claims 1-4, 11-14, 19 are allowed.

***Response to Arguments***

10. Applicant's arguments with respect to claims 5, 6, 10, 15, 20 have been considered but are moot in view of the new ground(s) of rejection. Please see detailed office action.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 18, 2005

A handwritten signature in black ink, appearing to read 'King Y. Poon', is positioned above the printed name.

**KING Y. POON**  
**PRIMARY EXAMINER**